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EXAMINER	
SON, LINH L D	

ART UNIT	PAPER NUMBER
2135	

DATE MAILED: 03/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/996,283	PARENTY, THOMAS J.	
	Examiner	Art Unit	
	Linh Son	2135	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 November 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *05/02*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This office action is responding to the application received on 12/13/2000.

2. Claims 1-23 are pending.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 1 recites the limitation "active agent" in "the first key management component transmitting the first key management component public key to the ***active agent*** computing platform over a secure channel". There is insufficient antecedent basis for this limitation in the claim. Examiner confuses on whether the "active agent" is referring to first active agent, second active agent, or a third. Examiner assumes the applicant meant the second active agent. Appropriate correction is necessary.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-3, 5, 7, 9-12, 14, 16, and 18-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Sasaki et al, US Patent No. 6351536, hereinafter "Sasaki".

7. As per claim 1, Sasaki teaches "A method of encrypting an object, comprising the steps of: a first active agent initiating the first key management component generating a first key management component public key/first key management component private key pair (Col 10 lines 14-17); loading an object encryption component; loading an object decryption component; creating a correlation table; a second active agent transmitting an encrypt object request to the first key management component (Col 3 lines 22-26, Col 9 lines 25-31); the first key management component transmitting an object encryption component to the second active agent computing platform over a secure channel (Col 9 lines 40-44); the first key management component transmitting the first key management component public key to the active agent computing platform over a secure channel (Col 9 lines 40-44); the object encryption component generating a symmetric key (Col 10 lines 5-9); the object encryption component encrypting a clear text object with the symmetric key (Col 9 lines 32-34); the object encryption component encrypting the symmetric key with the first key management component public key (Col 7 lines 50-59); the object encryption component creating an association between the encrypted symmetric key and the cipher text object (Col 2 lines 14-17 and Col 7 lines 50-59); the object encryption component transmitting the encrypted symmetric key to the first key management component or to a second key management component

having the first key management component private key (Col 7 lines 12-35) ; the object encryption component transmitting the association to the key management component having received the encrypted symmetric key (Col 7 lines 12-35); and, the key management component having received the association entering the association into the correlation table (Col 17 lines 18-23).

8. As per claim 3, Sasaki teaches "The method of claim 1, wherein the first key management component public key/first key management component private key pair is generated using an encryption algorithm selected from the group consisting of ECC and RSA (Col 10 lines 14-17).

9. As per claims 5 and 14, Sasaki teaches "The method of claims 1 and 14, wherein the object encryption/decryption component is installed on a browser" in (Col 2 line 64 thru Col 3 line 4).

10. As per claims 7 and 16, Sasaki teaches "The method of claims 5 and 14, wherein the object encryption component is implemented as a Java.[RTM.] applet" in (Col 9 lines 25-31).

11. As per claims 9 and 18, Sasaki teaches "The method of claims 1 and 18, wherein the object encryption component is comprised of a symmetric encryption algorithm selected from the group consisting of IDEA, DES, Blowfish, RC4, RC2, SAFER, and

AES" in (Col 7 lines 57-59).

12. As per claim 10, Sasaki teaches "A method of decrypting an object, comprising the steps of: an active agent transmitting a decrypt object request to the key management component (Col 14 lines 20-26); the key management component retrieving a cipher text object symmetric key from a correlation table (Col 8 lines 35-39); the key management component decrypting cipher text object symmetric key with the key management component private key (Col 7 line 66 thru Col 8 line 3); the key management component transmitting the object decryption component to the active agent computing platform over a secure channel (Col 14 lines 20-26); the key management component transmitting the cipher text object symmetric key to the active agent computing platform over a secure channel (Col 13 lines 58-67 and Col 14 lines 20-26); and the object decryption component decrypting the cipher text object with the cipher text object symmetric key (Col 13 lines 64-67).

13. As per claims 2 and 19, Sasaki teaches "A method of encrypting an object, comprising: under control of a first encryption server system, generating a public/private key pair for an encryption server system (Col 10 lines 14-17); under control of a client system, requesting an encryption program from an encryption server system (Col 3 lines 22-26, and Col 9 lines 25-31); requesting a server public key from an encryption server system (Col 3 lines 22-26, and Col 9 lines 25-31); under the control of an encryption server system, transmitting an encryption program to a client system over a

secure channel (Col 9 lines 40-44); transmitting a server public key to a client system over a secure channel (Col 9 lines 40-44); under control of a client system, receiving an encryption program from an encryption server system over a secure channel (Col 9 lines 40-44); receiving a server public key from an encryption server system over a secure channel (Col 9 lines 40-44); installing an encryption program on a client system; running an encryption program on a client system to generate a symmetric key (Col 10 lines 5-9); encrypting a clear text object with a symmetric key, thereby creating a cipher text object (Col 9 lines 32-34); creating a relationship between a cipher text object and a symmetric key; encrypting symmetric key with an encryption server public key, thereby creating an encrypted symmetric key (Col 7 lines 50-59); creating a relationship between a cipher text object and an encrypted symmetric key (Col 2 lines 14-17 and Col 7 lines 50-59); transmitting a cipher text object to an encryption server system; transmitting an encrypted symmetric key to an encryption server system; transmitting the relationship between a cipher text object and an encrypted symmetric key to an encryption server system (Col 7 lines 57-59 and Col 7 lines 12-35); under the control of an encryption server system, storing a cipher text object in a storage medium; storing an encrypted symmetric key in a storage medium (Col 7 lines 25-29); and storing the relationship between a cipher text object and an encrypted symmetric key in a storage medium (Col 17 lines 18-23).

14. As per claims 11-12, and 21, Sasaki teaches "An encryption system for transparent key management object encryption, comprising: an encryption server

system and a client system; an encryption server system, using the first entry in a correlation table to retrieve an encrypted symmetric key (Col 8 lines 35-39); decrypting a symmetric key using an encryption server system private key, thereby creating a decrypted symmetric key (Col 7 line 66 thru Col 8 line 3); inserting a symmetric key into a decryption program; sending a decryption program to a client system over a secure channel (Col 13 lines 58-67 and Col 14 lines 20-26); sending a cipher text object to a client system (Col 13 lines 55-57); under control of a client system, requesting a cipher text object from a server (Col 13 lines 55-57); under control of an encryption server system, installing a decryption program on a client system (Col 14 lines 20-31); and, decrypting a cipher text object using a decryption program, thereby creating a clear text object (Col 13 lines 64-67).

15. As per claim 22, Sasaki teaches " An encryption system for transparent key management object encryption, comprising: an encryption server system and a client system; under control of an encryption server system, generating a symmetric key (Col 13 lines 39-43); encrypting a clear text object with a symmetric key, thereby creating a cipher text object (Col 9 lines 32-34); inserting a symmetric key into a decryption program; sending a decryption program to a client system over a secure channel (Col 13 lines 58-67 and Col 14 lines 20-26); sending a cipher text object to a client system (Col 13 lines 55-57); under control of a client system, requesting a clear text object from a server (Col 13 lines 55-57); installing a decryption program on a client system (Col 14 lines 20-31); and, decrypting a cipher text object using a decryption program, thereby

creating a clear text object (Col 13 lines 64-67).

16. As per claims 20 and 23, Sasaki teaches "An encryption system for transparent key management object encryption, comprising: an encryption server system and a client system; an encryption server system, generating a public/private key pair for an encryption server system (Col 13 lines 39-43); transmitting an encryption program to a client system over a secure channel (Col 9 lines 40-44); transmitting a server public key to a client system over a secure channel (Col 9 lines 40-44); storing a cipher text object in a storage medium; storing an encrypted symmetric key in a storage medium; storing the relationship created between a cipher text object and an encrypted symmetric key in a storage medium (Col 7 lines 25-29); using the first entry in a correlation table to retrieve an encrypted symmetric key (Col 8 lines 35-39); decrypting a symmetric key using an encryption server system private key, thereby creating a decrypted symmetric key (Col 7 line 66 thru Col 8 line 3); inserting an encrypted symmetric key into a decryption program; sending a decryption program to a client system over a secure channel (Col 13 lines 58-67 and Col 14 lines 20-26); sending a cipher text object to a client system (Col 13 lines 55-57); decrypting an encrypted symmetric key using an encryption server system private key, thereby creating a decrypted symmetric key (Col 7 line 66 thru Col 8 line 3); sending a cipher text object to a client system (Col 13 lines 55-57); generating a symmetric key (Col 13 lines 39-43); encrypting a clear text object with a symmetric key, thereby creating a cipher text object (Col 13 lines 47-49); a client system, requesting an encryption program from an encryption server system (Col 3

lines 22-26 and Col 9 lines 25-31); requesting a server public key from an encryption server system (Col 10 lines 14-17); receiving an encryption program from encryption server system over a secure connection (Col 9 lines 40-44); receiving a server public key from an encryption server system over a secure channel Col 9 lines 40-44); installing an encryption program on a client system (Col 10 lines 5-9); running an encryption program on a client system to generate a symmetric key (Col 10 lines 5-9); encrypting a clear text object with a symmetric key, thereby creating a cipher text object (Col 9 lines 32-34); creating a relationship between a cipher text object and a symmetric key (Col 2 lines 14-17); encrypting symmetric key with an encryption server public key, thereby creating an encrypted symmetric key (Col 7 lines 50-59); creating a relationship between a cipher text object and an encrypted symmetric key (Col 2 lines 14-17; col 7 lines 50-59); transmitting an object encrypted with a symmetric key from a client system to an encryption server system (Col 7 lines 57-59); transmitting a symmetric key encrypted with a server public key from a client system to a encryption server system (Col 7 lines 57-59); transmitting the relationship between a cipher text object and an encrypted symmetric key to an encryption server system (Col 9 lines 32-35 and Col 7 lines 57-59); requesting a cipher text object from a server (Col 13 lines 55-57); installing a decryption program on a client system (Col 14 lines 20-31); and, decrypting a cipher text object using a decryption program, thereby creating a clear text object; and, requesting a clear text object from a server (Col 13 lines 64-67).

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

18. Claims 4, 6, 8, 13, 15, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sasaki.

19. As per claims 4 and 13, Sasaki teaches "The method of claims 1 and 10". However, Sasaki is silent on "the secure channel is an SSL channel". Nevertheless, Sasaki teaches an encrypted communication between the client's browser and the server in (Col 9 lines 40-44). Therefore, it would have been obvious at the time of the invention was made for one having ordinary skill in the art that the encrypted communication can be interpreted as SSL communication. It is well know that the encrypted communication between the client's browser and the server is provided by the SSL protocol.

20. As per claims 6 and 15, Sasaki teaches "The method of claims 5 and 14 and a web browser" in (Col 3 lines 3-25). However, Sasaki is silent on "wherein the browser is the Internet Explorer™. or the Navigator.™". Nevetheless, it would have been obvious at the time of the invention was made for one having ordinary skill in the art to realize

that the Internet Explore or the Navigator is well know to be the most popular web browser.

21. As per claims 8 and 17, Sasaki teaches "The method of claims 5 and 14 wherein the browser is the Internet Explorer.TM. and the object encryption component is implemented". However, Sasaki is silent on " wherein the browser is the Internet Explorer.TM. and the object encryption component is implemented *as an Active X.TM. control*". Nevertheless, Sasaki teaches of implementing the Java encryption applet in (Col 9 lines 25-31). Therefore, it would have obvious at the time of the invention was made for one having ordinary skill in the art that the Java encryption applet is well know to be an Active X.™ control.

Double Patenting

22. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

23. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

24. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

25. Claims 1-30 of the copending application No. 09735875, hereinafter '875, contain every element of claims 1-23 of the instant application No. 09735875, hereinafter '283, and as such anticipate(s) claims 1-23 of the instant application.

"A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

26. The following list of claims in '283 are teaching in the copending application '875:

'283	**'875**

1-3, 9, 18-19	1, 5-6, 8-13, 21, 24-26
4, 13	2
5, 7-8, 16-17	3, 15, 18, 21
6, 15	4, 16, 19, 22
10-12, 21	14, 17, 23, 28
14, 22	29
20, 23	7, 20, 27, 30

In detail:

27. Regarding claims 19 as exemplary in '283 and claims 1 in '875, recite an encryption method, and a system for sharing documents, comprising:

"under control of a first encryption server system, generating a public/private key pair for an encryption server system;" in '283

"under control of an encryption server system, generating a ECC public/private key pair for the encryption server system;" in '875 (The public/private key pair is ECC public/private key pair)

"under control of a client system, requesting an encryption program from an encryption server system; requesting a server public key from an encryption server system; under the control of an encryption server system, transmitting an encryption program to a client system over a secure channel;" in '283

"***under control of a client system, requesting a Java.RTM. encryption applet from the encryption server system; under control of a client system, requesting a***

Java.RTM. encryption applet from the encryption server system;" in '875 (The encryption program here is the Java.RTM. encryption applet)

"transmitting a server public key to a client system over a secure channel; under control of a client system, receiving an encryption program from an encryption server system over a secure channel; receiving a server public key from an encryption server system over a secure channel;" in '283

"***requesting an encryption server system EEC public key from the encryption server system; under the control of the encryption server system, transmitting the Java.RTM. encryption applet to the client system over a secure channel; transmitting the encryption server system EEC public key to the client system over a secure channel;" in '875***

"installing an encryption program on a client system; running an encryption program on a client system to generate a symmetric key; encrypting a clear text object with a symmetric key, thereby creating a cipher text object; creating a relationship between a cipher text object and a symmetric key; encrypting symmetric key with an encryption server public key, thereby creating an encrypted symmetric key; creating a relationship between a cipher text object and an encrypted symmetric key; transmitting a cipher text object to an encryption server system; transmitting an encrypted symmetric key to an encryption server system; transmitting the relationship between a cipher text object and an encrypted symmetric key to an encryption server system; under the control of an encryption server system, storing a cipher text object in a storage medium; storing an

encrypted symmetric key in a storage medium; and storing the relationship between a cipher text object and an encrypted symmetric key in a storage medium." In 283 ***"under control of a client system, receiving the Java.RTM. encryption applet from the encryption server system over a secure channel; receiving the encryption server system EEC public key from the encryption server system over a secure channel; installing the Java.RTM. encryption applet on the client system; running the Java.RTM. encryption applet on the client system to generate a Triple DES symmetric key; encrypting a clear text document with the Triple DES symmetric key, thereby creating a cipher text document; creating a relationship between the cipher text document and the Triple DES symmetric key; encrypting Triple DES symmetric key with the encryption server EEC public key, thereby creating an encrypted Triple DES symmetric key; creating a relationship between the cipher text document and the encrypted Triple DES symmetric key; transmitting the cipher text document to the encryption server system; transmitting the encrypted Triple DES symmetric key to the encryption server system; transmitting the relationship between the cipher text document and the encrypted Triple DES symmetric key to the encryption server system; under the control of the encryption server system, storing the cipher text document in a storage medium; storing the encrypted Triple DES symmetric key in a storage medium; and storing the relationship between the cipher text document and the encrypted Triple DES symmetric key in a storage medium." in '875 (the symmetric key in '283 is claimed more specifically as a Triple DES symmetric key).***

28. "The exemplary Claim 19 in '283 is generic to the species of invention covered by claim 1 of the copending patent. Thus, the generic invention is **"anticipated"** by the species of the patented invention. Cf., Titanium Metals Corp. v. Banner, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) (holding that an earlier species disclosure in the prior art defeats any generic claim) 4 . This court's predecessor has held that, without a terminal disclaimer, the species claims preclude issuance of the generic application. In re Van Ornum, 686 F.2d 937, 944, 214 USPQ 761, 767 (CCPA 1982); Schneller, 397 F.2d at 354. Accordingly, absent a terminal disclaimer, claims 12 and 13 were properly rejected under the doctrine of obviousness-type double patenting."
(In re Goodman (CA FC) 29 USPQ2d 2010 (12/3/1993).

29. Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Conclusion

30. Any inquiry concerning this communication from the examiner should be directed to Linh Son whose telephone number is (571)-271-3856.

31. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Kim Y. Vu can be reached at (571)-272-3859. The fax numbers for this group are (703)-872-9306 (official fax). Any inquiry of general nature or relating to the

status of this application or proceeding should be directed to the group receptionist whose telephone number is (571)-272-2100.

32. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval IPAIR.I system. Status information for published applications may be obtained from either Private PMR or Public PMR. Status information for unpublished applications is available through Private PMR only. For more information about the PAIR system, see http://pzr-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AU 2135

Linh LD Son

Patent Examiner